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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
09/497,943	02/04/2000	Mark Aaron Behlke	8098		
52229 7	590 04/20/2005	EXAMINER			
MICHAEL B	EST & FRIEDRICH I	SISSON, BRADLEY L			
ONE SOUTH I	PINCKNEY STREET	ART UNIT	PAPER NUMBER		
MADISON, WI 53701			1634		

DATE MAILED: 04/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application	n No.	Applicant(s)				
Office Action Summary		09/497,94		BEHLKE ET AL.				
		Examiner		Art Unit				
	· ·	Bradley L.	Sisson	1634				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply								
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).								
Status								
1)⊠ 2a)□ 3)□	☐ This action is FINAL . 2b) ☑ This action is non-final.							
Disposition of Claims								
5)□ 6)⊠ 7)□	Claim(s) 29-33,35,37-41,43-48,55,56 and 58-64 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration. Claim(s) is/are allowed. Claim(s) 29-33,35,37-41,43-48,55,56 and 58-64 is/are rejected. Claim(s) is/are objected to.							
Applicat	ion Papers							
9) ☐ The specification is objected to by the Examiner. 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
Priority (under 35 U.S.C. § 119							
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 								
Attachmen	ıt(s)							
1) Notice 2) Notice 3) Infor	ce of References Cited (PTO-892) ce of Draftsperson's Patent Drawing Review (PTO-948 mation Disclosure Statement(s) (PTO-1449 or PTO/Sl er No(s)/Mail Date		4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	nte	O-152)			

DETAILED ACTION

Specification

- 1. The use of the trademark NYLON, SEPHADEX, AMBION, and NEW ENGLAND BIOLABS have been noted in this application. They should be capitalized wherever they appears and be accompanied by the generic terminology.
- 2. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

New Matter

- 4. Claims 55 and 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
- 5. On 18 January 2002, an amendment was filed wherein claims 55 and 56 were added.

(New) The method of claim 29, wherein the Probe has a specific activity of at 55. least 7 x 107 CPM per picomole, and wherein the Probe comprises the Target Binding Domain, the Template Hybridization Domain and the Signal Domain.

(New) The method of claim 29, wherein the Probe has a specific activity of at least 9 x 107 CPM per picomole, and wherein the Probe comprises the Target Binding Domain, the Template Hybridization Domain and the Signal Domain.

While the specification teaches at page 36, lines 30-32, that a probe was generated that "had a specific activity of 7 x 10⁷ CPM per picomole," the specification has not been found to teach an open-ended range of specific activity. Accordingly, the open-ended range of specific activity constitutes new matter.

- 6. The following is a quotation of the second paragraph of 35 U.S.C. 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 7. Claims 29-33, 35, 37-41, 43-48, 55, 56, and 58-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 8. Claims 29-33, 35, 37-41, 43-48, 55, 56, and 58-64 are all drawn to a method of labeling an oligonucleotide. While the method is defined as comprising various steps, a "first oligonucleotide" is now defined in terms of is "consisting essentially of" certain domains. While the use of the phrase "consisting essentially of" is recognized as allowing for the inclusion of additional ingredients in a composition so long as it does not alter the basic novel features of said

Application/Control Number: 09/497,943 Page 4

Art Unit: 1634

composition, the term has not been defined in terms of what constitutes the basic and novel features of the oligonucleotide. Claims 30-33, 35, 37-41, 43-48, 55, 56, and 58-63, which depend form said claim 29, fail to overcome this issue and are similarly rejected.

9. Similar issues exist with respect to usage of the phrase in claim 32, 40, and 64.

Conclusion

- 10. Rejections and/or objections that appeared in the prior Office action and not repeated hereinabove have been withdrawn.
- 11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (571) 272-0751. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.
- 12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (571) 272-0745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
- 13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1634

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bradley L. Sisson Primary Examiner Art Unit 1634

B. d. Lisson

BLS 18 April 2005